

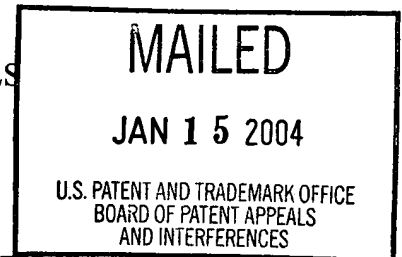
The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TROY D. ACTON,
WALTER A. HULLEMAYER, WILLIAM F. NETH
ROGER L. REUSS and CHARLES F. WINBURN



Appeal No. 2003-1592
Application 09/492,032

ON BRIEF

Before WARREN, TIMM and PAWLIKOWSKI, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner finally rejecting claims 1 through 15, 17, 19, 26, 28 through 31 and 43 through 47. Claims 16, 18, 20 through 25, 27 and 32 through 42 are also of record and have been allowed by the examiner. Claims 1, 12, 17, 28, 43 and 46 are illustrative of the claimed invention and the claims on appeal:

1. A sealable casket having a memorabilia compartment, said casket comprising:
a shell;
at least one cap pivoted to said shell;
said shell and at least one cap having respective confronting flanges;

a first gasket disposed between said flanges of said shell and at least one cap to seal therebetween;

a memorabilia compartment formed within said at least one cap and including an access opening and an interior;

a removable cove positioned over said access opening; and

a second gasket disposed between said cover and said at least one cap to seal therebetween.

12. The casket of claim 11 wherein said drawer support is an open-ended generally C-shaped channel.

17. The casket of claim 12 wherein said drawer is spring biased towards an outward position.

28. A casket comprising:

a shell;

at least one cap engaging the shell;

the cap including a header wall;

the header wall being formed to include an access opening;

a cover; and

a cam operable on an inside surface of the header wall which when actuated draws the cover toward the header wall.

43. A casket comprising:

a shell;

at least one cap engaging the shell;

the cap including a header wall;

the header wall being formed to include an access opening;

a cover; and

a gasket disposed between the cover and header wall.

46. A casket comprising:

a shell;

at least one cap engaging the shell;

a drawer carried by the cap for movement between an inward position and an outward position spaced-apart from the inward position;

a spring configured to yieldably bias the drawer away from the inward position; and

a gasket disposed between the drawer and the cap and configured to sealingly engage both of the drawer and the cap at least when the drawer is at the inward position.

The references relied on by the examiner are:

Shank (Shank '765)	2,937,765	May 24, 1960
Shanks (Shanks '941)	3,680,941	Aug. 1, 1972
Estes	4,962,574	Oct. 16, 1990
Lee	5,152,161	Oct. 6, 1992
Saaf	5,678,289	Oct. 21, 1997
Biondo	5,727,291	Mar. 17, 1998

The examiner has advanced the following grounds of rejection on appeal:

claims 1 through 11 and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Biondo in view of Estes, and further in view of Shanks '941 (answer, pages 3-5);

claims 12 through 15 and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over as being unpatentable over Biondo in view of Estes, in view of Shanks '941 as applied to claim 1 above, and further in view of Shank '765 (answer, pages 5-6);

claim 17 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Biondo in view of Estes, in view of Shanks '941, in view of Shank '765 as applied to claim 12 above, and further in view of Saaf (answer, page 6);

claims 28 and 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Biondo in view of Lee (answer, pages 6-7);

claims 30 and 31 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Biondo in view of Lee as applied to claim 28 above, and further in view of Shanks '941 (answer, page 7);

claim 43 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Biondo in view of Shanks '941 (answer, pages 7-8);

claims 44 and 45 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Biondo in view of Shanks '941 as applied to claim 43 above, and further in view of Lee (answer, page 8);

claim 46 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Biondo in view of Saaf, and further in view of Shanks '941 (answer, pages 8-9); and

claim 47 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Biondo in view of Saaf, in further view of Shanks '941, as applied to claim 46 above, and further in view of Lee (answer, page 9).

Appellants group the appealed claims, stating that the groups of claims are separately patentable (brief, pages 5-6). We note that groups I through IV and VIII encompass appealed independent claims 1, 28, 43 and 46 and appealed dependent claim 47, respectively, which are separately rejected, while groups V through VII each encompass claims representing more than one ground of rejection. We find that appellants do not present separate arguments for

patentability in either the brief or the reply brief for individual claims, but refer to groups of claims in arguments that group of grounds of rejection, wherein only the differences between elements in particular claims are noted and the groups of grounds of rejection are based on whether Shank '765, Shanks '941, or Lee is applied in the rejection (brief, pages 7-11, 11-13 and 13-15; reply brief, pages 1-4, 4-5 and 6-7).

37 CFR § 1.192(c)(7) (2002) provides:

For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to that ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

Accordingly, because appellants have not presented a specific argument with respect to any claim, we decide this appeal based on appealed claims 1, 12, 17, 28, 30, 43, 44, 46 and 47 as representative of the respective grounds of rejection. 37 CFR § 1.192(c)(7) (2002); *see In re McDaniel*, 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002) (“See 37 CFR 1.192(c)(7) (2001). If the brief fails to meet either requirement, the Board is free to select a single claim for each group of claims subject to a common ground of rejection as representative of all claims in that group and to decide the appeal of the rejection based solely on the selected representative claim.”).

We affirm the grounds of rejection involving appealed claims 1, 28, 30, 43, 44, 46 and 47, that is, the grounds of rejection in which Shanks '941 and/or Lee, but not Shank '765, are applied, and reverse the grounds of rejection involving appealed claims 12 and 17, that is, the grounds of rejection in which Shank '765 is applied.

Rather than reiterate the respective positions advanced by the examiner and appellants, we refer to the examiner's answer and to appellants' brief and reply brief for a complete exposition thereof.

Opinion

We have carefully reviewed the record on this appeal and based thereon find ourselves in agreement with the supported finding advanced by the examiner that as a matter of law, *prima facie*, one of ordinary skill in this art would have found in the combined teachings of Biondo and Estes, Shanks '941, Saaf and/or Lee as applied in the grounds of rejection of appealed claims 1, 28, 30, 43, 44, 46 and 47, the reasonable suggestion to modify the memorabilia drawer in the casket of Biondo as suggested by Shanks '941 and/or Lee, in the reasonable expectation of sealing and/or locking the memorabilia drawer. *See Pro-Mold and Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629-30 (Fed. Cir. 1996); *In re Fritch*, 972 F.2d 1260, 1265-66, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992); *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Laskowski*, 871 F.2d 115, 10 USPQ2d 1397 (Fed. Cir. 1989); *In re Fine*, 837 F.2d 1071, 1074-76, 5 USPQ2d 1596, 1598-1600 (Fed. Cir. 1988); *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981) ("The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.").

Accordingly, since a *prima facie* case of obviousness has been established over the combined teachings of Biondo and Estes, Shanks '941, Saaf and/or Lee as applied with respect to appealed claims 1, 28, 30, 43, 44, 46 and 47, we have again evaluated all of the evidence of obviousness and nonobviousness based on the record as a whole, giving due consideration to the weight of appellants' arguments in the brief and reply brief. *See generally, Oetiker, supra; In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984).

Appellants present essentially the same argument with respect to the application of Shanks '941 and/or Lee, that is, these references cannot be combined with Biondo, either alone or as combined with Estes and/or Saaf, because both Shanks '941 and Lee are directed to drawers in articles of manufacture that are not caskets containing memorabilia drawers, and thus, these

references are not related to the claimed invention (brief, e.g., pages 8-9, 10-11 and 14-15; reply brief, e.g., pages 1-3 and 6-7).

We determine that because there is no factual basis to conclude, and the examiner does not contend, that Shanks '941 and Lee are within the field of appellants' endeavor, the issue raised by appellants is whether the subject matter and the problems addressed by Shanks '941 and by Lee are reasonably similar to each other and to the problems addressed by the claimed memorabilia drawer containing casket that the references in fact constitute analogous prior art that would have been considered by one of ordinary skill in this art. We find that both Shanks '941 and Lee are analogous art with respect to the claimed invention because each reference "is reasonably pertinent to the particular problem with which the inventor is involved," that is, each reference is involved with the modification of a drawer in order to isolate and secure the contents therein from the environment outside of the drawer, which problems are addressed by appellants with respect to the modification of the memorabilia drawer in order to isolate and secure the memorabilia therein to preserve it from the environment of the closed casket, and thus each reference "is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem." *In re Clay*, 966 F.2d 656, 659-60, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992).

Indeed, we find that Shanks '941 would have disclosed to one of ordinary skill in the art¹ that a gasket will seal a drawer from the environment of the refrigerator, maintaining the conditions in the drawer when it is closed, such that it "retains the ambient moisture of the space and precludes the ingress of dry air and any odors which normally may be present in the refrigerator interior . . . for extended periods of time" (col. 1, lines 6-16). We further find that Lee would have disclosed to one of ordinary skill in the art that a cam lock will address the problem of a loose fitting locked drawer (col. 1, lines 5-24).

¹ It is well settled that a reference stands for all of the specific teachings thereof as well as the inferences one of ordinary skill in this art would have reasonably been expected to draw therefrom, see *In re Fritch*, 972 F.2d 1260, 1264-65, 23 USPQ2d 1780, 1782-83 (Fed. Cir. 1992); *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968), presuming skill on the part of this person. *In re Sovish*, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985).

Therefore, we are of the opinion that not only is Shanks '941 and Lee analogous prior art, but each would have provided the teaching, suggestion and motivation to one of ordinary skill in this art to combine the teachings of modifications to isolate and secure the contents of a drawer therein with the teachings of a memorabilia drawer of the casket of Biondo in the reasonable expectation of providing a sealed, locked memorabilia drawer in the casket for preservation of that memorabilia. *See, e.g., Pro-Mold and Tool, supra; Keller, supra; see also In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002); *Smith Industries medical Systems, Inc. v. Vital Signs, Inc.*, 183 F.3d 1347, 1356, 51 USPQ2d 1415, 1420-21 (Fed. Cir. 1999); *In re Mayne*, 1043 F.3d 1339, 1342, 41 USPQ2d 1451, 1454 (Fed. Cir. 1997); *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 9292, 933 (Fed. Cir. 1984).

Accordingly, based on our consideration of the totality of the record before us, we have weighed the evidence of obviousness found in combined teachings of Biondo and Estes, Shanks '941, Saaf and/or Lee as applied in the grounds of rejection with appellants' countervailing evidence of and argument for nonobviousness and conclude that the claimed invention encompassed by appealed claims 1 through 11, 19, 28 through 31 and 43 through 47 would have been obvious as a matter of law under 35 U.S.C. § 103(a).

We do not reach the same result with respect to appealed claims 12 and 17. The examiner has included Shank '765 in the combination of references applied to these claims. Appellants contend that this reference discloses a sliding shelf structure and not a drawer (brief, page 12). While the examiner initially found that Shank '765 disclosed a slidable "drawer" assembly (answer, page 5), in response to appellants' argument, the examiner "acknowledges Shank discloses a sliding self structure" but contends that "Shank is of a similar problem solving area, namely sliding mechanisms for pull out devices" (*id.*, page 11). Appellants respond that the reference does not disclose a slidable drawer assembly (reply brief, page 5).


We determine that while there is some similarity between a shelf and a drawer, we find no disclosure in Shank '765 which would have suggested to one of ordinary skill in this art that the slide mechanism specific for a shelf as disclosed therein would be applicable to a drawer, and the examiner has not provided any scientific reasoning or objective evidence in support of the contention that the sliding mechanism of the reference is applicable to "pull out devices"

generally, including a drawer. Accordingly, in the absence of such reasoning or evidence, the examiner has not established a factual foundation in support of the grounds of rejection involving appealed claims 12 through 15, 17 and 26, and in the absence of a *prima facie* case, we reverse these grounds of rejection. *See generally, In re Rouffet*, 149 F.3d 1350, 1358, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998)\ (“hindsight” is inferred when the specific understanding or principal within the knowledge of one of ordinary skill in the art leading to the modification of the prior art in order to arrive at appellant’s claimed invention has not been explained).

The examiner’s decision is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART


CHARLES F. WARREN

CHARLES F. WARREN
Administrative Patent Judge

Catherine Zimm

CATHERINE TIMM
Administrative Patent Judge

Beverly A. Lawrence

BEVERLY A. PAWLIKOWSKI
Administrative Patent Judge

BOARD OF PATENT APPEALS AND INTERFERENCES

Appeal No. 2003-1592
Application 09/492,032

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